



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/200,509 11/25/98 YELLOP

A 07703/280001

┌

PM82/0109

└

EXAMINER

STEPHAN J FILIPEK
FISH & RICHARDSON
45 ROCKEFELLER
NEW YORK NY 10111

BARTUSKA, F	
ART UNIT	PAPER NUMBER

2167
DATE MAILED:

01/09/01

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/200509

Applicant(s)

YELLOP et al

Examiner

F.J. BARTUSK 2/67

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11-27-00
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5, 7 AND 9-19 is/are rejected.
- ☒ Claim(s) 6 AND 8 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2167

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Best, of record. The criteria for the counterfeit coins can be prevented from being considered by selecting the K' acceptance band or allowed to be considered by selecting the K acceptance band.

3. Claims 1, 9 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Griner, cited herewith. Fig. 4 of Griner shows that coins that are rejected as nickels and quarters are then tested as dimes, see col. 6, lines 6-43. Therefore, the measured properties of dimes are checked against two sets of criteria, each set corresponding to a predetermined type of article, the dimes are rejected and then subsequently the measured properties are checked against the criteria for dimes.

Art Unit: 2167

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-5, 7, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griner in view of Best. Griner shows all the features of the applicants' claimed invention except altering the sets of criteria prior to issuing a valid signal. Best discloses in col. 5, lines 42-55 altering the sets of criteria prior to issuing a valid signal to switch to a wide band for one criteria if the coin has

Art Unit: 2167

already met a narrow band of another criteria or vice versa so that the coin does not have to meet the narrow band of each criteria and therefore fewer good coins will be erroneously rejected. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Best to modify the device of Griner to include means to alter the criteria prior to acceptance of coins by switching between narrow and wide bands to limit the number of good coins erroneously rejected.

Allowable Subject Matter

6. Claims 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. The applicants' remarks have been considered but have not been found persuasive in view of the art as now applied to claims 1-5, 7 and 9-13. With respect to claims 14 and 15 the applicants argue that the removal or addition of a set of criteria could be for any article, counterfeit or not. Claims 14 and 15 call broadly for a single one of the sets of criteria to be added or removed. Therefore, the removal or addition of any one of the criteria, even the criteria of the

Art Unit: 2167

counterfeit coins, meets the limitations of these claims. The applicants argue that claims 16 and 17 allow for changing the sets of denominations that are to be accepted. It is noted that the limitation: "denominations", does not appear in these claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2167

9. Any inquiry concerning this communication should be directed to F. J. Bartuska at telephone number (703) 308-1111.


F. J. BARTUSKA
PRIMARY EXAMINER 4/6/01